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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/112,276	07/09/1998	TSE HO KEUNG		6721

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EXAMINER

BARRON JR, GILBERTO

ART UNIT	PAPER NUMBER
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2132

23

DATE MAILED: 08/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/112,276

Applicant(s)

HO KEUNG, TSE

Examiner

Gilberto Barrón Jr.

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/578,448.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

***Response to Amendments***

1. The multitude of letters, amendments, requests and other correspondence submitted by Applicant from at least March of 2001 to the present date has resulted in a substantial delay in the prosecution of the instant application. Applicant is advised that responses to Office actions should be complete and in a single submission. Applicant is requested to refrain from submitting "corrections" to problems found or to submit new proposals for amending claim language based Applicant's instant desire to revise claims.

2. Applicant is requested to provide a "clean" copy of all claims each time a proposed amendment is filed and not just the ones proposed for amendment

***Drawings***

3. The specification on page 3, provides a Brief Description of the Drawings, Figures 1 and 2. However, there were no sheets of drawings in the application papers filed July 9, 1998. If Applicant intends to submit such Figures now, Applicant is required to show that 1) NO NEW MATTER is being entered, and 2) the figures are the same as those provided for in the specification as filed. Applicant may simply state that the Figures are the same as those of the parent application, if such is the case, in order to meet the "no new matter" requirement

4. Applicant is requested to submit these figures in response to this action.

***Double Patenting***

5. Claims 1-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of co-

pending Application No. 08/587,448. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-22 of this application are broader than claims 1-15 of the parent application. The subject matter of application claims 1-22 is obvious from the subject matter of co-pending parent claims 1-15, i.e. there does not appear to be any substantial difference between the claims in the parent application and this application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Applicant is advised that abandonment of the parent application is not required, but would obviate this double patenting rejection and would not require relinquishing the priority date established by the parent. A terminal disclaimer in this application would also obviate this double patenting rejection and does not require abandonment or relinquishing priority date. In either case, withdrawal of priority date is not required.

### ***Specification***

7. The sole amendment to the specification that has been entered is the addition of the last paragraph on page 11 and requested changes of amendment filed March 3, 2001. Any other amendments have not been entered, due variously to new matter, unclear instructions and confusion caused by the numerous replies sent in by Applicant.

8. Applicant is advised that references or amendments to "psychological barrier" in the specification will trigger new matter rejections, due to no showing that this subject matter was present in the parent claim. Applicant's arguments that this "in effect" was a part of the parent application is not convincing as the immediate specification language

appears to be Applicant's most recent characterization of the invention and not a part of the original written disclosure as originally submitted.

***Response to Arguments***

9. Applicant's arguments filed with the "Formal Amendment Filed April 2, 2001" have been fully considered but they are not persuasive. With respect to claims 7-12, these claims do not require the "without causing a said operation being performed" limitation.

10. Applicant's arguments with respect to claims that positively recite the "without causing a said operation being performed" limitation are persuasive. However, due to these limitations being newly added, further search has been necessary and has resulted in newly discovered prior art. The discovery of the new prior art has necessitated new grounds of rejection. These new grounds of rejection follow below.

***Claim Rejections - 35 USC § 112***

11. Claims 1, 9, 11 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite for the term "means/information". The use of the term "means" invokes the 6<sup>th</sup> paragraph of section 35 USC 112. This requires the interpretation of "means" to correspond to what is disclosed in the specification. The use of "means/information" does not allow determination of what is disclosed in the specification, e.g., is it information or a software module.

Claim 1, is indefinite as "favourable" is a relative term and it is not clear to whom would apply "favourable". It is suggested to use terms that are present in the specification that correspond to this step.

Claims 9 and 11 are indefinite because the claim a "carrier wave". A carrier wave is not a physical thing, as such it cannot be claimed.

Claim 22 is indefinite because it seeks to patent a program per se. A program per se is a data structure and not a physical thing. Applicant should redraft these claims to recite "A computer readable medium having program code for causing a computer to execute the method steps of claims \_\_\_\_".

***Claim Rejections - 35 USC § 102***

12. Claims 7-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Wiedemer (4,796,181)

The first patent to Wiedemer (4,796,181) discloses a billing system for computer software. Figure 1 shows the components of the billing system. This system meets the limitations of independent claims 7 and 10.

The SECURITY MODULE 16 corresponds to the recited Identity software. Column 6, lines 41-49 describes that the billing module provides information for enabling a billing operation to the user take place whenever the protected software is to be executed.

The Diskette start program shown in Figure 1 as part of element 14 corresponds to the recited authorizing software module. Column 5, lines 33-36, describes that the start program must verify the presence of the security module, i.e., the identity module.

The protected software will not be executed if the identity software, i.e. the billing module is not present, see column 2, lines 33-69.

The billing that takes place when the protected software executes in Wiedemer meets the recitation of the payment operation for which the authorized user is responsible for as per claims 7 and 10.

***Claim Rejections - 35 USC § 103***

13. Claims 1, 2, 4, 14, 15 and 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiedemer (4,796,181) in view of Haas et al (5,719,938 issued February 17, 1998, filing date August 1, 1994).

The Wiedemer patent provides for an identity means to determine authorization if a user and provides for information that leads to a billing charge, but does not disclose the step of not causing a charge or electronic commerce operation to be performed.

The patent to Haas teaches a method for providing secure access to shared information such as a newspaper, see column 1, lines 20-35. The Haas patent teaches deterrents for discouraging users from providing useful information to others to access the information in question. Column 5, lines 47-54 teach a first deterrent as causing a rightful user's credit card number to display to discourage a rightful user from sharing the information to access the secured information to others.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Wiedemer method as taught in Haas by causing a rightful user's credit card number to be displayed in order to discourage rightful user's from sharing information with others who are not the rightful user(s).

The limitations claims 2 and 14 that recite the authentication of the identity software is met by the operation of "checking that the external code and the internal code on the security module which are unique to any individual user are correct", see column 7, lines 15-46 of Wiedemer.

14. Claims 12, 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiedemer (5,155,680) in view of Haas et al (5,719,938 issued February 17, 1998, filing date August 1, 1994).

The second Wiedemer patent (5,155,680) discloses a billing system similar to the first Wiedemer patent above and provides the same components. However, the variation of the billing system described in this patent also provides for PIN, i.e., password protection. Column 14, lines 40-43 describe that this correct information be provided from the user to allow the protected software to be executed as per claims 12, 13 and 15. Wiedemer discloses an identity means to determine authorization if a user and provides for information that leads to a billing charge, but does not disclose the step of not causing a charge or electronic commerce operation to be performed.

Haas teaches a method for providing secure access to shared information such as a newspaper, see column 1, lines 20-35. The Haas patent teaches deterrents for discouraging users from providing useful information to others to access the information in question. Column 5, lines 47-54 teach a first deterrent as causing a rightful user's credit card number to display to discourage a rightful user from sharing the information to access the secured information to others.



It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Wiedemer method as taught in Haas by causing a rightful user's credit card number to be displayed in order to discourage rightful user's from sharing information with others who are not the rightful user(s).

15. Claims 3, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiedemer (4,796,181) in view of Cooper (5,737,416) as applied to claim 1 above, and further in view of Haas et al (5,719,938 issued February 17, 1998, filing date August 1, 1994).

Claim 3 provides for the authorizing software module to authenticate the computer. While claims 5 and 6 provide for the protected software to include validating information for identity information and encrypted identity information. The identity information and the encrypted information are to be compared to determine validity of the protected software. Wiedemer discloses an identity means to determine authorization if a user and provides for information that leads to a billing charge, but does not disclose the step of not causing a charge or electronic commerce operation to be performed. Further, Wiedemer does not describe the application information as providing the validation information or the authentication of the computer.

The Cooper patent is a system for allowing trial period use of software. The system provides protected software to be used if certain access conditions are met. Figure 32 shows that the system uses machine ID, including customer information to be part of a file that must be present and validated for access to the protected software. Figure 24 shows that the protected software includes encrypted validation information

for checking the integrity of the information used to determine validity. Column 20, lines 1-19 and col. 23, lines 3-16 describe the use of the machine ID to authenticate the computer and that use of the encrypted validity information to validate the identity information.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wiedemer as taught in Cooper by use of a machine ID to authenticate the computer and of the encrypted validity information to validate the identity information in order to authenticate not only the user but the computer that is being used.

Haas teaches a method for providing secure access to shared information such as a newspaper, see column 1, lines 20-35. The Haas patent teaches deterrents for discouraging users from providing useful information to others to access the information in question. Column 5, lines 47-54 teach a first deterrent as causing a rightful user's credit card number to display to discourage a rightful user from sharing the information to access the secured information to others.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Wiedemer method as taught in Haas by causing a rightful user's credit card number to be displayed in order to discourage rightful user's from sharing information with others who are not the rightful user(s).

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gilberto Barrón Jr. whose telephone number is (703) 305-1830. The examiner can normally be reached on Mondays thru Thursdays from 8:00 AM to 5:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, either Mr. Albert Decady, who can be reached on (703) 305-9595, or Ms. Gail Hayes, who can be reached on (703) 305-9711, may be contacted for assistance.

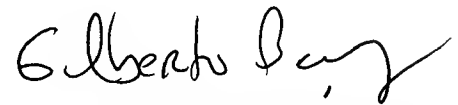
The fax phone number for OFFICIAL responses for the organization where this application or proceeding is assigned is (703) 746-7239.

The fax phone number for AFTER FINAL responses for the organization where this application or proceeding is assigned is (703) 746-7238.

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The fax phone number for DRAFT proposals for the organization where this application or proceeding is assigned is (703) 746-7240

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



**GILBERTO BARRON  
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